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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/628,500 | 07/28/2003 | Makoto Miyazawa | NEKU 20.544 | 5066 |
| 26304 | 7590 | 06/15/2006 | EXAMINER | |
| KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585 | | | NGUYEN, KHIEM D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2823 | |

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,500

Applicant(s)

MIYAZAWA ET AL.

Examiner

Khiem D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 4-6 is/are allowed.
6) ☒ Claim(s) 1,3 and 7 is/are rejected.
7) ☒ Claim(s) 8-18 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Applicants' Arguments

1. Applicants' arguments, see Applicants' Amendment in Pages 12 and 13, filed March 24th, 2006, with respect to the rejection(s) of claim(s) 1, 3 and 7-18 under 35 U.S.C. 103(a) rejection have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the Applicants' Admitted Prior Art (AAPA) in this application and Chang (U.S. Patent 6,611,407).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

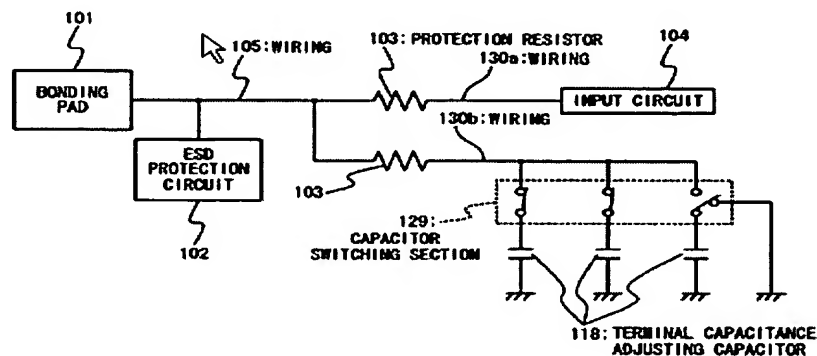
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the Applicants' Admitted Prior Art (AAPA) in this application.

In re claim 1, AAPA discloses a semiconductor integrated circuit device comprising: a terminal 101; and a first capacitance adjusting section 129 which is connected to a wiring 105 between the terminal 101 and a protection resistor 103 in a front stage of an internal circuit 104; and a protection circuit 102 which is connected to the wiring 105 between the terminal 101 and the first capacitance adjusting section 129, the protection circuit 102 inherently protecting the internal circuit 104, wherein the first capacitance adjusting section 129 adjusts terminal capacitance of the terminal 101, based

on capacitance of the first capacitance adjusting section (AAPA, Background of the invention, Description of the Related Art in Pages 3-4 and FIG. 3).

Fig. 3 PRIOR ART



Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

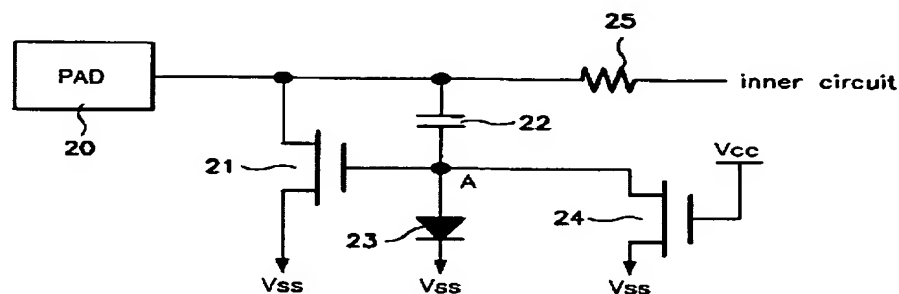
5. Claims 1, 3 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang (U.S. Patent 6,611,407).

In re claim 1, **Chang** discloses a semiconductor integrated circuit device comprising: a terminal 20; and a first capacitance adjusting section 22 which is connected to a wiring (unlabeled) between the terminal 20 and a protection resistor 25 in a front stage of an internal circuit (inner circuit); and a protection circuit 21 which is connected to the wiring between the terminal 20 and the first capacitance adjusting section 22, the

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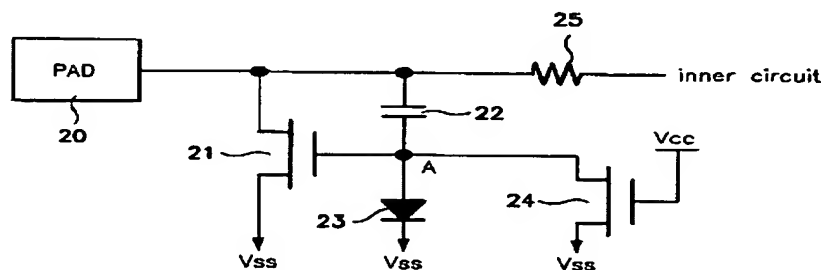
protection circuit 21 inherently protecting the internal circuit, wherein the first capacitance adjusting section 22 adjusts terminal capacitance of the terminal 20, based on capacitance of the first capacitance adjusting section (col. 3, lines 28-56 and FIG. 2).

FIG.2



In re claim 3, Chang discloses a semiconductor integrated circuit device comprising: a terminal 20; and a first capacitance adjusting section 22 which is connected to a wiring (unlabeled) between the terminal 20 and a protection resistor 25 in a front stage of an internal circuit (inner circuit), wherein the first capacitance adjusting section 22 adjusts terminal capacitance of the terminal 20, based on capacitance of the first capacitance adjusting section, wherein the first capacitance adjusting section 22 comprises a first adjusting capacitor which adjusts the terminal capacitance (col. 3, lines 28-56 and FIG. 2), and

FIG.2



In re claim 7, as applied to claim 1 above, **Chang** discloses all claimed limitations including the limitation wherein the first capacitance adjusting section comprises a first adjusting capacitor which adjusts the terminal capacitance, the first adjusting capacitor comprises: a first semiconductive portion which is composed of a first well region **36** (n-well) formed in a substrate **31** (P-substrate) with the internal circuit and having a conductive type opposite to that of the substrate, and a second semiconductive portion **37** (P+) which is opposite to the first semiconductive portion and is composed of a first

diffusion layer region formed in the first well region 36 and having the same conductive type as that of the substrate (col. 4, lines 3-34 and FIG. 3).

Allowable Subject Matter

6. Claims 4-6 are allowed over prior art of record.
7. Claims 8-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons for Allowance

8. The following is an examiner's statement of reasons for allowance:

After further search and consideration of Applicants' response filed September 21st, 2005 (see Applicants' response in Page 12 of the September 21st response), it is determined that the prior art of record neither anticipates nor renders obvious the claimed subject matter of the instant application as a whole either taken alone or in combination, in particular, prior art of record does not teach "wherein said first capacitance adjusting section further comprises a second adjusting capacitor which adjusts said terminal capacitance based on controlling a well region potential by said well potential control section, wherein said second adjusting capacitor comprises: a third semiconductive portion which is composed of a second well region formed in said substrate and having a conductive type opposite to that of said substrate, a fourth semiconductive portion which is opposite to said third semiconductive portion and is composed of a second diffusion layer region formed in said second well region and having the same conductive type as

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that of said substrate, and wherein said well potential control section controls said well region potential of said second well region”, as recited in independent claim 4.

Claims 5 and 6 are also allowed as being directly or indirectly dependent of the allowed independent base claim.

Response to Applicants' Amendment and Arguments

9. Applicants' arguments with respect to claims 1, 3 and 7-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khiem D. Nguyen whose telephone number is (571) 272-1865. The examiner can normally be reached on Monday-Friday (8:30 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on (571) 272-1907. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

K.N.

June 09, 2006

Brook Kebede
BROOK KEBEDE
PRIMARY EXAMINER